

Appl. No. 10/669,848
Reply to Examiner's Action dated May 8, 2006

REMARKS/ARGUMENTS

The Applicant has carefully considered this application in connection with the Examiner's Action and respectfully requests reconsideration of this application in view of the foregoing amendment and the following remarks.

The Applicants originally submitted Claims 1-21 in the application. The Applicants have amended Claims 1 and 11 and have canceled Claims 8, 9, 18 and 19. The Applicants previously canceled Claims 4 and 14 and have not added any claims. Accordingly, Claims 1-3, 5-7, 10-13, 15-17 and 19-21 are currently pending in the application.

I. Rejection of Claims 1, 2, 5-7, 11, 12, 15-17 and 21 under 35 U.S.C. §102

The Examiner has rejected Claims 1, 2, 5-7, 11, 12, 15-17 and 21 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,512,919 to Ogasawara. As the Examiner is no doubt aware, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference; the disclosed elements must either be disclosed expressly or inherently and must be arranged as in the rejected claims.

Ogasawara does not anticipate the present invention because Ogasawara does not disclose a database supplying information about an article to the mobile telephone based on a received, decoded form of coded data derived from an image, where the information includes a price of the article expressed in at least two national currency values, at least one of which is selected by the user of the mobile telephone. Thus, Ogasawara does not disclose each and every element of the claimed invention.

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Inasmuch as Ogasawara does not disclose each and every element of the claimed invention and, as such, is not an anticipating reference with respect to independent Claims 1, 11 and 21, and because Claims 2, 5-7, 12 and 15-17 are each respectively dependent upon either Claim 1 or Claim 11, Ogasawara also cannot be an anticipating reference for Claims 2, 5-7, 12 and 15-17. Accordingly, the Applicants respectfully request the Examiner to withdraw the §102 rejection with respect to these Claims.

II. Rejection of Claims 3 and 13 under 35 U.S.C. §103

The Examiner has rejected Claims 3 and 13 under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of U.S. Patent Application No. 20020102966 by Lev, *et al.* (Lev). One criteria to be met to establish a prima facie case of obviousness is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

As indicated above, Ogasawara does not disclose a database supplying information about an article to the mobile telephone based on a received, decoded form of coded data derived from an image, where the information includes a price of the article expressed in at least two national currency values, at least one of which is selected by the user of the mobile telephone. Inasmuch as Lev does not overcome this shortcoming of Ogasawara with respect to independent Claims 1 and 11 on which Claims 3 and 13 depend, Ogasawara, individually or in combination with Lev, fails to

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teach or suggest the invention recited in independent Claims 11 and 11. Thus, dependent Claims 3 and 13, when considered as a whole, are not obvious in view of Ogasawara in view of Lev.

In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 3 and 13 under 35 U.S.C. §103(a). The Applicants therefore respectfully request the Examiner withdraw the rejection.

III. Rejection of Claims 9 and 19 under 35 U.S.C. §103

The Examiner rejected Claims 9 and 19 under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of U.S. Patent Application No. 20050017453 by Rehbein, *et al.* (Rehbien). Although Claims 9 and 19 have been canceled, the limitations therein are now contained in newly amended Claims 1 and 11. Therefore, this rejection of Claims 9 and 19 will be addressed as if directed to Claims 1 and 11.

As indicated above, Ogasawara does not disclose a database supplying information about an article to the mobile telephone based on a received, decoded form of coded data derived from an image, where the information includes a price of the article expressed in at least two national currency values, at least one of which is selected by the user of the mobile telephone. Rehbein does not overcome this shortcoming. A criterion to be met in establishing a *prima facie* case of obviousness is there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The art in this case is non-analogous. As the Examiner points out, the handheld device in Rehbein could be a cellular phone, which would bring Rehbein within the same

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field of endeavor as Ogasawara. However, Rehbein, as relied on by the Examiner, was filed on February 2, 2004, which was subsequent to the September 24, 2003 filing date of the present application. Although Rehbein claims the benefit of the earlier filing date of U.S. Patent Application No. 20040083111 by Rehbein, *et al.*, which application was filed on October 25, 2001, the provision in Rehbein relied on by the Examiner regarding Rehbein disclosing a cellular telephone as reading on the claimed "mobile phone" so as to make the art analogous was not in the filing made on October 25, 2001. Therefore, the Applicants invention predates the cited reference to the extent the references constitute analogous art. Inasmuch as the art is not analogous, Claims 9 and 19, when considered as a whole, were not obvious in view of Ogasawara in view of Rehbein and, for the same reason, Claims 1 and 11 are similarly not obvious.

In view of the foregoing remarks, the cited references did not support the Examiner's rejection of Claims 9 and 19 under 35 U.S.C. §103(a) nor would the cited references support the rejection of amended Claims 1 and 11.

IV. Rejection of Claims 10 and 20 under 35 U.S.C. §103

The Examiner rejected Claims 10 and 20 under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of U.S. Patent Application No. 200500140230 by Swartz, *et al.* (Swartz) and further in view of Lev. One criteria to be met to establish a prima facie case of obviousness is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

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As indicated above, Ogasawara does not disclose a database supplying information about an article to the mobile telephone based on a received, decoded form of coded data derived from an image, where the information includes a price of the article expressed in at least two national currency values, at least one of which is selected by the user of the mobile telephone. Inasmuch as neither Swartz nor Lev overcome this shortcoming of Ogasawara with respect to independent Claims 1 and 11 on which Claims 10 and 20 depend, Ogasawara, individually or in combination with Swartz, Lev or a combination thereof, fails to teach or suggest the invention recited in independent Claims 1 and 11. Thus, dependent Claims 10 and 20, when considered as a whole, are not obvious in view of Ogasawara in view of Swartz and further in view of Lev.

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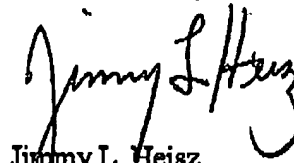
V. Conclusion

In view of the foregoing amendment and remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-3, 5-7, 10-13, 15-17 and 19-21.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

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